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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,180	08/04/2000	Mitchell Anthony DeLong	8191	2275

27752 7590 09/10/2003

THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
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CINCINNATI, OH 45224

EXAMINER

WRIGHT, SONYA N

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/633,180	DELONG, MITCHELL ANTHONY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sonya Wright	1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-11, 13, 14, 16, 28 and 30-50 is/are pending in the application.

4a) Of the above claim(s) 34-50 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1 is/are rejected.

7) ☒ Claim(s) 2-11, 13, 14, 16, 28, and 30-33 is/are objected to.

8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some \*   c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

This Office Action is in response to Applicant's amendment filed 6-19-03. Claims 1 and 28 have been amended. Claims 12, 15, 17-27, and 29 have been canceled. Claims 1-11, 13, 14, 16, 28, and 30-33 are pending in this application.

The rejections under 35 U.S.C. 102, 103 and 112 which were set forth in the Office Action mailed 12-19-03 have been overcome with Applicant's amendments. The objection to claim 1 for missing the definition of R14 has been overcome with Applicant's amendments.

The objection to claims for containing non-elected subject matter has been maintained.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The above claims are directed to a 2-decarboxy-2-phosphinico prostaglandin derivative wherein R2 is a "mono- or polyvalent inorganic cation and a mono- or polyvalent organic cation". The terms "mono- or polyvalent inorganic cation" and "mono- or polyvalent organic cation" lack description in the specification. The terms

“mono- or polyvalent inorganic cation” and “mono- or polyvalent organic cation” are broad. Applicant does not define the term “mono- or polyvalent inorganic cation” and “mono- or polyvalent organic cation” nor does Applicant give examples which are recognized in the art as representative of the “mono- or polyvalent inorganic cation” and “mono- or polyvalent organic cation” instantly claimed. There is no data or correlative prior art evidence which supports Applicant’s claim that at the time of filing they were in possession of compounds containing said “mono- or polyvalent inorganic cation” and “mono- or polyvalent organic cation” as asserted in the claims. There is no evidence of record to guide one of ordinary skill in the art in preparing compounds containing a “mono- or polyvalent inorganic cation” or a “mono- or polyvalent organic cation”.

### ***Claim Objections***

Claims 2-11, 13, 14, 16, 28, 30, 31, 32, and 33 are objected to because of the following informalities:

Claims 2-11, 13, 14, 16, 28, 30, 31, 32, and 33 are objected to because they depend from claim 1, which is rejected.

Claim 11 is objected to because it appears that the last word of the claim, “position” was typed in error. It is suggested that Applicant delete the last word of claim 11, “position”.

Claims 30, 31, 32, and 33 contain 2-decarboxy-2-phosphinico prostaglandin derivatives which are drawn to non-elected subject matter. It is requested that Applicant

limit the 2-decarboxy-2-phosphinico prostaglandin derivatives in claims 30, 31, 32, and 33 to those that are in claim 1. Appropriate correction is required.

Claims 34-50 have been withdrawn from consideration because they are drawn to non-elected subject matter. It is suggested that Applicant cancel claims 34-50.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged

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or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

  
\_\_\_\_\_  
Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

September 4, 2003